

REMARKS

Response To Rejections

Response To Claim Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 1-24 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, the Office Action indicates that it is unclear if the claimed “polymer” of instant claims 1, 11, and 23 pertain to a polymer composition comprising a sacrificial polymer, a photoinitiator and a solvent (claim 10) or if the “polymer” has sacrificial component and a photoinitiator component (*i.e.*, copolymer). The Examiner further states “[f]or the purposes of examination, the Examiner has interpreted the claims to pertain to a composition comprising a sacrificial polymer, a photoinitiator and a solvent (claim 10).

With respect to claims 1 and 11, Applicants have amended these claims to recite a “polymer composition...,” and the respective dependent claims accordingly. These claims and respectfully assert that the rejection has been rendered moot. With respect to the rejection of claim 23, Applicants respectfully traverse the rejection. The polymer of claim 23 is not recited as including a sacrificial polymer, a photoinitiator, and a solvent. Applicants respectfully submit that the claim language on its face is definite. Applicants therefore respectfully request that the rejection of claims 1-24 on this ground be withdrawn.

The Examiner stated that “Claim 10 recited the limitation ‘the solvent’ in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.” *Office Action at 2*. Applicants have amended claim 10 to add the proper antecedent basis and therefore respectfully request that the rejection be withdrawn.

Applicants wish to clarify that the foregoing amendments have been made for purposes of better defining the invention in response to the rejections made under 35 U.S.C. § 112, and not in response to the rejections made based on prior art. Indeed, Applicants submit that no substantive limitations have been added to the claims. Therefore, no prosecution history estoppel arises from these amendments. *Black & Decker, Inc. v. Hoover Svc. Ctr.*, 886 F.2d 1285, 1294 n. 13 (Fed. Cir. 1989); *Andrew Corp. v. Gabriel Elects., Inc.*, 847 F.2d 819 (Fed. Cir. 1988); *Hi-Life Prods. Inc. v. Am. Nat'l. Water-Mattress Corp.*, 842 F.2d 323, 325 (Fed. Cir. 1988); *Mannesmann Demag Corp.*

v. Eng'd Metal Prods. Co., Inc., 793 F.2d 1279, 1284-1285 (Fed. Cir. 1986); *Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986).

Response To Claim Rejections Under 35 U.S.C. §102

Claims 1-2, 4-8, 10-12, and 14-27 stand rejected under 35 U.S.C. §102(a) as allegedly being anticipated by *Wu et al.* (Journal of the Electrochemical Society). Applicants respectfully traverse this rejection. Without admitting whether the *Wu et al.* reference anticipates or renders obvious the claimed invention, the *Wu et al.* reference does disclose the Applicants' own work. All of the joint inventors of the present application are also co-authors of the *Wu et al.* reference. The co-inventor, Paul A. Kohl, has submitted an affidavit under 37 CFR 1.132, attached hereto, alleging that the *Wu et al.* reference is his own work and that the subject matter of the *Wu et al.* reference was carried out in his lab and/or under his supervision.

This situation is directly analogous to that described in *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). In that case, the inventor Katz stated in a declaration that the co-authors of the publication, Chiorazzi and Eshhar, "were students working under the direction and supervision of the inventor, Dr. David H. Katz." *Id.* The court held that this declaration, in combination with the fact that the publication was a research paper, was enough to establish Katz as the sole inventor and that the work described in the publication was his own. *See id.* The court found that in research papers, students involved only with assay and testing are normally listed as co-authors but are not considered co-inventors. *See id.*; *see also* MPEP §2132.01

Therefore, because Applicants' disclosure of their own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. 102(a), Applicants respectfully request that the rejection be withdrawn.

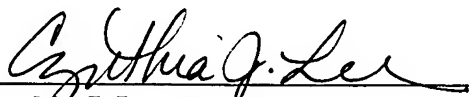
Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-27 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephone conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,


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